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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,367	05/04/2001	Shigeo Yanai	TESJ.0030	6795

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EXAMINER
SOTOMAYOR, JOHN

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/848,367	Applicant(s) YANAI ET AL.
	Examiner John L Sotomayor	Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

2. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

3. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 9-16, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding these claims, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Additionally, the phrase "and/or" does not present the elements of the claim in alternative form and thus renders the claim indefinite.

6. Claims 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of these claims is an improper multiple claim which makes it impossible to determine the dependency of the claims rendering them indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-5, 7-9, 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Macri et al (US 6,183,259).

9. Regarding claim 1, Macri et al discloses an instructional system for a plurality of activities with a computerized menu of basic examples of problem points (Col 9, lines 64-67 and Col 10, lines 1-10), a sub-menu which is displayed by clicking one of these problem points (Col 10, lines 14-34), a computer by which improved performance can be recorded edited and searched (Col 5, lines 13-22), and means through which concrete examples may be presented as image, textual or auditory representations (Col 5, lines 18-32).

10. Regarding claims 3 and 4, Macri et al discloses utilizing the Internet as in claim 3, or a computer system as in claim 4, as means of recording, editing, processing through operations and searching the data for methods for improvement as recorded on images (Col 3, lines 16-30).

11. Regarding claims 5,7 and 8, Macri et al discloses that through instructor interaction as in claim 5, through the Internet as in claim 7, and through a computer system as in claim 8, the learner can view images for improvement and, through repetition, can be made to understand the proper method needed for improvement (Col 6, lines 23-37).

12. Regarding claim 9, Macri et al discloses that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37).

13. Regarding claims 11-13 and 15-16, Macri et al discloses that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37) through the use of the Internet as in claims 11 and 15, a computer system as in claims 12 and 16, or an instructor as in claim 13 (Col 3, lines 16-30).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 2, 6, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macri et al in view of Studor et al (US 6,152,856).

18. Regarding claim 2, Macri et al discloses utilizing the Internet as in claim 3, or a computer system as in claim 4, as means of recording, editing, processing through operations and searching the data for methods for improvement as recorded on images (Col 3, lines 16-30). Macri et al does not specifically disclose using a DVD for performing the same functions. However, Studor et al teaches that a DVD system may be used to store and display higher quality video images (Col 6, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a DVD for recording, editing, processing through operations and searching data for methods of improvement as recorded on images. Combining the system described by Macri et al with the teaching of Studor et al would provide a higher quality and longer lasting record for use in improving the skill of the user.

19. Regarding claim 6, Macri et al discloses that through instructor interaction, the Internet, and through a computer system, the learner can view images for improvement and, through repetition, can be made to understand the proper method needed for improvement (Col 6, lines 23-37). Macri et al does not specifically disclose using a DVD for performing the same functions. However, Studor et al teaches that a DVD system may be used to store and display

higher quality video images (Col 6, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a DVD for showing images so that the learner can be made to understand the proper method for improvement. Combining the system described by Macri et al with the teaching of Studor et al would provide a higher quality image to deepen the understanding of the user in understanding the proper method for improvement.

20. Regarding claims 10 and 14, Macri et al discloses that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37). However, Studor et al teaches that a DVD system may be used to store and display higher quality video images (Col 6, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a DVD for showing images so that the learner can be made to understand the proper method for improvement. Combining the system described by Macri et al with the teaching of Studor et al would provide a higher quality image to deepen the understanding of the user in the proper method for improvement.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lubell et al (US 6,159,016) for a discussion of side-by-side comparison of video frames showing sport activity and how to improve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Sotomayor whose telephone number is 703-305-4558. The examiner can normally be reached on 6:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4558.

jls
September 13, 2002

Joe H. Cheng
Primary Examiner